

Serial No. : 10/613,264

Page 9

REMARKS

REJECTION UNDER 35 U.S.C. 102(b) OVER CULP

Claims 1, 8, 13 and 15 have been rejected under 35 USC §102(b) as being anticipated by Culp '965.

The Examiner has taken the position that Culp discloses a vertical support bracket 28 with a locking hitch ball coupler lever 63 that pivots about the backwall of vertical element 18 in a manner similarly to the present application and that the coupler lever locks in position in a known manner.

Applicant strongly traverses Examiner's position. The coupler of Culp does not pivot. It is raised and lowered in a vertical plane by means of the raising and lowering of vertical support bracket 28. None of the figures of Culp illustrate the coupler in anything but a perpendicular position relative to the vertical support bracket. The device of Culp accomplishes bi-directional vertical movement of the carriage means by action of the assembly of wheels in the first channel means (col. 7, lines 44-47 *inter alia*). The device of Culp, to avoid rotational movement about the coupler ball, utilizes a second coupler mounted adjacent the first coupler, Figs. 13 & 15. The device of Culp prevents pivoting. In contrast, Applicant's device is intended to allow pivoting movement of the boat docking stabilizer device mounted on a dock or the like where the device pivots about pivoting pin 62.

Additionally, and in reference to claim 15, Culp provides no locking means. The coupler of Culp moves in a vertical plane as described above in response to the water level. The only locking means Culp envisions is the addition of a padlock (col. 6, line 68). The device of Applicant in contrast provides means for locking in either a ready position, with the coupling device pivoted upwardly as shown in Fig. 4, for ease of use when docking a boat, such that the user can grab and remove the locking pin permitting the coupling device to be released for docking with the boat-mounted ball, the locked position with the coupler device attached to the ball mounted on a boat, shown in Fig. 7. The means for locking the hitch ball coupler in a ready position and in a locked position is provided by moving a locking pin, received by a tube carried by the hitch ball coupler, into a different pair of apertures in the vertical support bracket such that the hitch ball coupler remains in

Serial No. : 10/613,264

Page 10

a desired position. (Supported in the original specification at page 2, lines 2 - 5, *inter alia*.)

In order to support a rejection of anticipation under 35 U.S.C. §102(b), the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the pending claim, is required. *Corning Glass Works, v. Sumitomo Electric*, 9 USPQ 2d 1962, 1965 (Fed. Cir. 1989) *SSIH Equip, S.A. v. USITC*, 218 USPQ 678 (Fed Cir. 1983); *Connell v. Sears, Roebuck & Co.*, 220 USPQ 193 (Fed.Cir. 1983); *Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick co., et al.*, 221 USPQ 481, 485 (Fed.Cir. 1984). The following analysis must be successfully carried out before the issue of anticipation can be reached.

1. The elements of the pending claims must be identified.
2. The meaning of the various elements of the pending claims must be determined in light of the supporting specification.
3. The corresponding elements disclosed in the allegedly anticipating reference must be identified.

When this analysis is carefully carried out, it is clear that the issue of the anticipation of the present claims 1, 8, 13, and 15 by Culp has not been reached.

Accordingly, it is respectfully submitted that the Examiner has not met the burden of establishing a sustainable finding of anticipation of the present claims over Culp. The withdrawal of this ground of rejection is seen to be in order and is requested.

REJECTION OF CLAIMS AND UNDER 35 U.S.C. 103 OVER CULP IN VIEW OF FULTON

Claims 2, 9 and 16 have been rejected under 35 USC §103(a) as being unpatentable over Culp in view of the Fulton coupler handle.

The remarks made and the court cases relied upon in regard to the rejection *supra* over Culp

Serial No. : 10/613,264

Page 11

are considered equally pertinent to this rejection and are here repeated.

It is respectfully submitted that any of the teaching of Fulton with regard to a handle cannot further serve to buttress the Examiner's attempted rejection of claims 2, 9 and 16 since the basic portion of the rejection of claims 1, 8, 13 & 15 based on Culp is not on sound ground. The withdrawal of this ground of rejection is also seen to be in order and is requested.

A *prima facie* case of obviousness requires a finding that a combination of prior art references contain all the elements found in the current claims. As stated above, Culp does not contain all of the elements of the application of Applicant. In neither Culp nor Williams is there any indication of pivoting of the coupler. In all the references the coupler is fixed mounted to mounting place or similar element rather than being pivotably attached to an upright element as in the invention of Applicant.

Additionally, a *prima facie* case of obviousness requires a finding that the references themselves provide the basis for modification of the prior art. A combination of the teachings of the prior art references is proper only if there is some objective teaching in the prior art that would lead one of ordinary skill in the art to combine the relevant teachings of the references. *In Re Fine*, 5 USPQ 2d 1596, 1598 (Fed. Cir. 1988). See also *In re Rinehart*, 189 USPQ 143, 147 (CCPA 1976). ("A *prima facie* case of obviousness is established when the teachings from the prior art itself would appear to have suggested the claimed subject matter to a person of ordinary skill in the art"). See also *In re Geiger*, 815 F.2d. 686, 688, 2 USPQ 2d(BNA) 1276, 1278 (Fed. Cir. 1987); *Diversitech Corp. v. Century Steps, Inc.*, 850 F.2d 675, 678-679, 7 USPQ 2d (BNA) 1315, 1318 (Fed. Cir. 1988) (stating that there was not any suggestion, contained in the prior art, that the inventor's combination of teachings would achieve the demonstrated results).

Coupled with the requirement that there must be some suggestion or motivation to combine the prior art teachings is an additional requirement that the suggestion or motivation exist before the date of invention. It is incorrect for the Examiner to formulate the suggestion or motivation based upon current knowledge. The Federal Circuit has stated:

Serial No. : 10/613,264

Page 12

It is impermissible to use the claimed invention as an instruction manual or "template" to piece together the teachings of the prior art so that the claimed invention is rendered obvious. This court has previously state that "[o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention." *Fritch*, 972 F. 2d 1266, 23 USPQ2d (BNA) at 1784 (quoting *In re Fine*, 837 F. 2d 1071, 1075, 5 USPQ 2d (BNA) 1596, 1600 (Fed. Cir. 1988).

Examiner has failed to make a *prima facie* 103 rejection. Examiner must either point out something in the prior art as a whole to suggest the desirability and thus the obviousness of making the combination or withdraw this ground of rejection.

Further, even if Examiner had not failed to make a *prima facie* 103 rejection, Examiner cannot simply cite different features of the claimed invention from different sources unless the Examiner explains the suggestion or motivation to combine or modify the prior art references. *Fritch*

The references must be taken in their entireties, including those portions which argue against obviousness. *Bausch & Lomb v. Barnes-Hind/Hydrocurve, Inc.*, 230 USPQ 416, 420 (Fed. Cir. 86). It is impermissible within the framework of a section 103 to pick and choose from a reference only so much of it as will support a conclusion of obviousness to the exclusion of other parts necessary to a full appreciation of what the reference fairly suggests to one skilled in the art. *Id.* at 419.

PRIOR ART OF RECORD AND NOT RELIED UPON

Examiner points to reference Williams, US Pat. No. 4,613,149, as having a standard trailer ball coupler and two retained positions.

The remarks made and the court cases relied upon in regard to the rejection *supra* over Culp are considered equally pertinent to this rejection and are here repeated.

The invention of Williams teaches use of an extender apparatus to aid in the use of a standard trailer ball coupler by a single user. There are no pivoting parts in Williams. Williams neither anticipates nor in combination with Culp makes obvious the invention of applicant. None of the art

Serial No. : 10/613,264

Page 13

referenced by Examiner includes means for pivoting of the coupler device.

CLAIMS OBJECTED TO BUT ALLOWABLE IF REWRITTEN IN INDEPENDENT FORM

Claims 3 - 7, 10 - 12 and 17 - 20 have been objected as being dependent upon a rejected base claims but would be allowable if rewritten in independent form.

The remarks made and the court cases relied upon in regard to the rejection *supra* over Culp, Fulton and Williams are considered equally pertinent to this rejection and are here repeated.

Applicant asserts that the above-indicated claims are allowable in their present form and such is requested. As stated above, the prior art lists non-pivoting apparatus and therefore lacks a basic element as herein claimed.

Amendments to the claims were to correct typographical and grammatical mistakes and to more clearly identify that which is claimed, and were not an attempt to claim around the art Examiner cited.

CONCLUSION

With the present amendment of the specification and the claims, and in light of the above remarks, all of the claims should now be seen to be in condition for allowance. The prompt issuance of a formal notice to that effect is seen to be in order and is solicited. Should the Examiner consider that any minor matters remain to be resolved prior to the issuance of a Notice of Allowance, the Examiner is invited to telephone the undersigned attorney to achieve prompt resolution thereof.

Respectfully submitted,

Janet P. Schafer, 32,296
Attorney at Law
727 Torchwood Circle

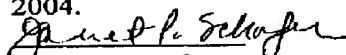
Serial No. : 10/613,264

Page 14

New Brighton, MN 55112-2538
651-633-8261

CERTIFICATE OF FACSIMILE TRANSMISSION

I certify that this Amendment, Amendment Transmittal Letter, Petition for Extension of Time, Certificate of Facsimile Transmission, and any other papers mentioned as included herein, is being transmitted by facsimile to the Examiner at Group 3617 at fax number (703)872-9306 at 2 PM central daylight time, May 17, 2004.


Janet P. Schaffer
Patent Attorney